

Vinson & Elkins
ATTORNEYS AT LAW

VINSON & ELKINS L.L.P.
2300 FIRST CITY TOWER
1001 FANNIN STREET
HOUSTON, TEXAS 77002-6760
TELEPHONE (713) 758-2222
FAX (713) 758-2346
www.vclaw.com

Margaret J. Sampson
Direct Dial 512/542-8569
Direct Fax 512/236-3264
msampson@vclaw.com

September 10, 2004

VIA FACSIMILE (703/746-9195)

Office of Initial Patent Examination
Filing Receipt Corrections
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

CERTIFICATE OF FACSIMILE TRANSMISSION

I, certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 703/746-9195):

September 10, 2004 *Margaret J. Sampson*
Date Margaret J. Sampson

Re: U. S. Patent Application Serial No. 10/806,494 entitled "Methods for Preventing Photodamaged Skin by Administering Selegiline or Desmethyleselegiline" by Resnick
(Our Ref: SOM700/4-009(A)8CON2/64001)

Sir:

In response to the Notice Regarding Benefit/Priority Claim dated August 23, 2004, enclosed please find the following documents:

- 1) Updated Initial Application Data Sheet for SN 10/806,494; and
- 2) Copy of Notice Regarding Benefit/Priority Claim dated 8/23/04.

We request a corrected filing receipt indicating priority information for the applications as shown on the enclosed initial application data sheet.

Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Commissioner is hereby authorized to deduct said fees from VINSON & ELKINS L.L.P. Deposit Account No. 22-0365/SOM700/4-009(A)8CON2/64001.

Respectfully submitted,

Margaret J. Sampson

Margaret J. Sampson
Reg. No. 47,052

1864:3058
Enclosure
468534_1.DOC



UNITED STATES PATENT AND TRADEMARK OFFICE

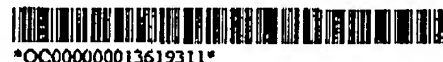
COPY

 UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1459
 Alexandria, Virginia 22313-1459
 www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/806,494	03/23/2004	Mark G. Resnick	SOM700/4-009(A) 8CON2/6400

Margaret J. Sampson
 VINSON & ELKINS LLP
 2300 First City Tower
 1001 Fannin Street
 Houston, TX 77002-6760

CONFIRMATION NO. 2768



OC000000013619311

Date Mailed: 08/23/2004

Notice Regarding Benefit/Priority Claim(s)

☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed nonprovisional application(s) is improper because there is no specific reference for each prior-filed application that includes: (1) the identification of the prior-filed application by application number, or international application number and international filing date; and (2) a clear indication the relationship (i.e., continuation, divisional, or continuation-in-part) of the nonprovisional applications. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---," in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed application(s) as required by 37 CFR 1.78. A proper relationship includes an identification of each nonprovisional application as a continuation, divisional or continuation-in-part application of the immediate prior-filed nonprovisional application for which a benefit is claimed under 37 CFR 1.78 in order to establish copendency throughout the entire chain of prior-filed applications. The specific reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed. See 37 CFR 1.78(a).

☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed provisional application(s) is improper because the instant

application was not filed within twelve (12) months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---, which claims the benefit of U.S. Provisional Application No. 60/---,--- filed---" in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed applications (including an indication of any intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed with 12 months of the filing date of the provisional application) as required by 37 CFR 1.78. The required reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed during the pendency of the instant application.

☐ **Improper Priority Claim(s) to Prior-Filed Foreign Application(s)**

The instant application was not filed within twelve (12) months from the filing date of the prior-filed foreign application, and there is no benefit claim to an intermediate nonprovisional application filed within 12 months of the filing date of the foreign application. Applicant should review each priority claim submitted and, if appropriate, provide the proper reference to any intermediate nonprovisional application filed within 12 months of the filing date of the foreign application in compliance with 37 CFR 1.78, or delete the priority claim. The required reference to an intermediate nonprovisional application must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for the benefit claim to an intermediate nonprovisional application must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed.

☐ **Benefit Claims to More Than 400 Prior-Filed Applications**

The Office's automated system to record and capture benefit claims is only capable of recording benefit claims for 400 prior-filed applications. Therefore, the Office is unable to generate a filing receipt containing benefit claims for more than 400 prior-filed applications even though applicant is entitled to submit benefit claims for more than 400 prior-filed applications. Accordingly, applicant should not request a corrected filing receipt to include benefit claims for more than 400 prior-filed applications.

☒ **Prior-Filed Nonprovisional Application has been Improperly Indicated as a National Stage (35 U.S.C. 371) Application**

Applicant submitted a benefit claim to a prior-filed nonprovisional application and improperly indicated that the prior-filed application is a national stage application under 35 U.S.C. 371. The Office's records show that the prior-filed application is an application filed under 35 U.S.C. 111(a). The Office has entered the benefit claim to the prior-filed application as a benefit claim to an application filed under 35 U.S.C. 111(a). Any request for a corrected filing receipt to include the indication that the prior-filed application is a national stage application will not be granted unless applicant supplies evidence that the prior application was in fact a national stage application. Accordingly, applicant should not submit such request without such evidence. Applicant should submit an amendment (or an application data sheet (ADS) if the benefit claim was submitted in an ADS) to delete the indication that the prior-filed application is a national stage application.

For more information and examples on benefit claims, please see Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. 119(e), 120, 121, and 365(c), 1268 Off. Gaz. Pat. Office 89 (March 18, 2003), which is available on the USPTO website at <http://www.uspto.gov/web/offices/com/sol/og/2003/wcck11/patbene.htm>, and the Manual of Patent Examining Procedure (MPEP) §§ 201.11 and 201.14.

PART 2 - COPY TO BE RETURNED WITH RESPONSE

Initial Information Data Sheet

Inventor Information

Inventor One Given Name: Mark G.
Family Name: Resnick
Postal Address Line One: 10106 Bennington Drive
City: Tampa
State or Province: Florida
Postal or Zip Code: 33626
Citizenship Country: United States

Correspondence Information

Name Line One: Margaret J. Sampson
Name Line Two: VINSON & ELKINS LLP
Address Line One: 2300 First City Tower
Address Line Two: 1001 Fannin Street
City: Houston
State or Province: TX
Postal or Zip Code: 77002-6760
Telephone: (512) 542-8569
Fax: (512) 236-3264

Application Information:

Title Line One: METHODS FOR PREVENTING PHOTODAMAGED SKIN BY
Title Line Two: ADMINISTERING SELEGILINE OR
DESMETHYLSELEGILINE
Total Drawing Sheets: 0
Formal Drawings?: No
Application Type: Utility
Docket No.: SOM700/4-009(A)8CON2/64001

Representative Information

Registration Number 47,052
Representative Customer No.: 21,586

Continuity Information

This application is a: Continuation of
>Application One: 10/215,492
Filing Date: August 8, 2002

Which is a: Continuation of
>Application Two: 09/663,218
Filing Date: September 15, 2000

which claims priority to: 60/078,043 filed March 16, 1998

And which is a:	Continuation of
>Application Three:	PCT/US99/04588
Filing Date:	March 3, 1999